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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Krent/Paffett/Teifert, Inc.

International Class: 28

Serial No.: 75/848,813

Published for Opposition: July 9, 2002

Official Gazette: Vol. 1260, No. 2, Page TM 459

Filed: November 15, 1999

Mark: PLANET EARTH

Attorney Docket No.: KPEP62358

Goods: illustrated sporting balls

PLANET EARTH SKATEBOARDS, INC., a
California corporation.

Opposition No. _____

NOTICE OF OPPOSITION

Opposer,

v.

KRENT/PAFFETT/TEIFERT, INC., a
Massachusetts corporation,

Applicant.

NOTICE OF OPPOSITION

Seattle, Washington 98101

October 4, 2002

TO THE COMMISSIONER FOR TRADEMARKS

TRADEMARK TRIAL AND APPEAL BOARD:

Planet Earth Skateboards, Inc., a corporation of the State of California, having a place of business at 2453 Cades Way, Suite B, Vista, California 92083 (hereinafter "Opposer"), believes that it will be damaged by registration of the trademark PLANET EARTH as requested by U.S.

KPEP00511281.DOC

-1-

CHRISTENSEN
O'CONNOR
JOHNSON

LAW OFFICES

1400 FIFTH AVENUE
SUITE 1200
SEATTLE, WA 98101

1 Trademark Application Serial No. 75/848,813, filed November 15, 1999, and hereby opposes the
2 same. As grounds for the opposition, Opposer alleges as follows:

3 1. On information and belief, Applicant, Krent/Paffett/Teifert, Inc., is a corporation of
4 the State of Massachusetts, having a place of business at 34 Farnsworth Street, Boston,
5 Massachusetts 02210 (hereinafter "Applicant").

6 2. Continuously since long prior to any date upon which Applicant can rely, Opposer has
7 used the trademarks PLANET EARTH and PLANET EARTH PRODUCTS in association with the
8 sale of skateboards, skateboard related products, clothing, and sporting goods.

9 3. Opposer is the owner of U.S. Trademark Registration No. 2,183,202 for the mark
10 PLANET EARTH for high performance skateboards and skateboard wheels. Said registration issued
11 August 25, 1998 in International Class 28, setting forth a date of first use of January 1991.

12 4. Opposer is the owner of U.S. Trademark Registration No. 2,185,219 for the mark
13 PLANET EARTH for clothing, namely, pants, shirts, t-shirts, sweatshirts, jackets, hats, and shorts.
14 Said registration issued September 1, 1998 in International Class 25, setting forth a date of first use
15 of January 1991.

16 5. Sporting balls are sold in the same channels of trade in which Opposer sells
17 skateboards, skateboard related products, clothing, and sporting goods.

18 6. The mark PLANET EARTH claimed by Application Serial No. 75/848,813 is
19 identical to Opposer's mark PLANET EARTH and therefore, when used in association with sporting
20 balls, is likely to cause confusion, or to cause mistake, or to deceive within the meaning of
21 Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

22 7. Opposer will be damaged by issuance of the registration requested by Application
23 Serial No. 75/848,813 insofar as the registration requested will constitute *prima facie* evidence of the
24 validity of the registration, Applicant's ownership of the mark PLANET EARTH, and Applicant's
25

KP2P20031202.DOC

-2-

CHRISTENSEN
O'CONNOR
JOHNSON

LAW OFFICE

1400 FIFTH AVENUE
SUITE 1800
DENVER, CO 80202-1500

1 exclusive right to use the mark PLANET EARTH in association with the sale of sporting balls when,
2 in fact, Applicant is not entitled to such rights by virtue of Opposer's prior and continuous use of the
3 marks PLANET EARTH and PLANET EARTH PRODUCTS in association with the sale of
4 skateboards, skateboard related products, clothing, and sporting goods.

5 8. For the reasons stated above, issuance of a registration as requested by Application
6 Serial No. 75/848,813 will cause injury and damage to Opposer's right to the continuous and
7 exclusive use of the marks PLANET EARTH and PLANET EARTH PRODUCTS in association
8 with the sale of skateboards, skateboard related products, clothing, and sporting goods.

9 WHEREFORE, Opposer respectfully requests that registration of the mark PLANET EARTH
10 for the goods claimed by Application Serial No. 75/848,813 as requested by Applicant be denied
11 pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) and that this opposition be
12 sustained.

13 Accompanying the duplicate signed copies of this Notice of Opposition is our Check
14 No. 142576 for the required filing fee in the amount of \$300.00 (\$300.00 per class). Please
15 charge any excess fees to Deposit Account No. 03-1740 of Opposer's counsel noted below.

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1 Please direct all correspondence to Cindy L. Caditz of Christensen O'Connor Johnson
2 Kindness^{PLLC} at the following address:

3 Cindy L. Caditz, Esq.
4 Christensen O'Connor Johnson Kindness^{PLLC}
5 1420 Fifth Avenue, Suite 2800
6 Seattle, WA 98101-2347

7 Please direct all telephone calls to Cindy L. Caditz at 206-682-8100.

8 Respectfully submitted,

9 CHRISTENSEN O'CONNOR
10 JOHNSON KINDNESS^{PLLC}

11 *Cindy Caditz*
12 Cindy L. Caditz
13 Attorneys for Opposer

14 I hereby certify that this NOTICE OF OPPOSITION to U.S. Trademark Application Serial
15 No. 75/848,813 for the mark PLANET EARTH is being deposited with the U.S. Postal Service in a
16 sealed envelope as first class mail with postage thereon fully prepaid and addressed to the
17 Commissioner for Trademarks, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington,
18 VA 22202-3513, on the below date.

19 Date:

20 October 4, 2002

21 *Jeffrey Harbert*

22 CLC:jh

23 K:\EP\0203\1282.DOC

24 -4-

25 CHRISTENSEN
O'CONNOR
JOHNSON

LAW OFFICES

1420 FIFTH AVENUE
SUITE 2800
SEATTLE, WA 98101-2347

02/20/03 11:18 FAX

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS
120 FIFTH AVENUE
SUITE 2800
SEATTLE WASHINGTON 98101
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DATE
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PAY TO THE ORDER OF
DIRECTOR - U.S. PATENT AND TRADEMARK OFFICE
WASHINGTON DC 20231

[Signature]

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS LLC

DIRECTOR - U.S. PATE

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INVOICE DATE
10/04/2002

CLIENT
KPEP

MATTER
0020531

INVOICE NUMBER
100402.17

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300.00

- File Notice of Opposition
DIRECTOR - U.S. PATENT AND
TRADEMARK OFFICE

File No.: KPEP-A-2058 Date: 10/4/02
Atty/Secy: CLC:jh Serial No.: 75/648,813
Parties: Planet Earth Skateboards, Inc. v. Krent/Pellet/Telfert, Inc.
Mark: PLANET EARTH
Int'l Class(es): 28

The following documents have been received in the U.S. Patent and Trademark
Office, ATTN: TTAB, on the date stamped hereon via first-class mail, with a signed
Certificate of Mailing:

Notice of Opposition (4 pages, in duplicate)
Check for \$300.00 for filing fee #142576

Received from < > at 2/20/03 2:18:33 PM (Eastern Standard Time)

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS
1420 FIFTH AVENUE
SUITE 2000
SEATTLE, WASHINGTON 98101
(206) 462-0100

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500 OLIVE WAY
SEATTLE, WA 98101

142576
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DATE

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PATENT AND TRADEMARK OFFICE
13-19-0001
19-02-2002
FOR CREDIT TO THE
U.S. TREASURY

**CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}**
1420 Fifth Avenue, Suite 2800
Seattle, WA 98101-2347
206.682.8100
Facsimile No. 206.224.0779

FACSIMILE COVER SHEET

DATE: February 20, 2003

TO: Ms. Tina Craven
United States Patent and Trademark Office

FACSIMILE NO: 1-703-746-7121

RE: Opposition Against Trademark Application Serial
No. 75/848,813 for the mark PLANET EARTH

OUR REFERENCE: KPET-6-2358

FROM: Margaret P. Au, Paralegal
Direct Dial: (206) 695-1785
E-mail: margaret@cojck.com

(Facsimile No. 206.224.0779)

MESSAGE: Dear Ms. Craven,

Thank you for returning my telephone call. As requested, I attach a copy of the Notice of Opposition which was previously submitted to the Trademark Trial and Appeal Board. A Certificate of Mailing is on Page 4 of the Notice of Opposition, certifying that said document was deposited with the U.S. Postal Service as first class mail, postage prepaid and addressed to the Trademark Trial and Appeal Board on October 4, 2002.

Also enclosed is a copy of canceled Check No. 142576 in the amount of \$300 submitted with the Notice of Opposition in payment of the opposition fee, which shows that the fee was received by the Patent and Trademark Office.

Please review the attached and let me know if you require any further information or documents. Thank you for your attention.

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We have 7 pages to send, including this sheet. If any pages need to be retransmitted, please call 206.682.8100, Ext. 1771, within 15 minutes.

MFA/jh